

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG. 27, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re LeGrand Bennett and Anne Bennett dba Wisor Co.

Serial No. 74/700,586

Henri J.A. Charmasson for LeGrand Bennett and Anne Bennett

Anil V. George, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney)

Before Simms, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

LeGrand Bennett and Anne Bennett (applicants) have
appealed from the final refusal of the Trademark Examining
Attorney to register on the Principal Register the asserted
mark shown below

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for sun visors and caps.¹ In the application applicants describe their mark as follows:

The mark consists of a brim configuration for a sun visor or cap, said brim being spherically-curved, extending beyond the temple areas, and covering the ears of the visor or cap wearer.

By amendment, applicants further state that the stippling on the drawing is to reflect the shape of the brim and not to indicate color. Applicants' actual visor is shown below (from the specimens of record).

Applicants and the Examining Attorney have submitted briefs but no oral hearing was requested. We affirm in part and reverse in part.

¹ Application Ser. No. 74/700,586, filed July 13, 1995, based upon applicants' allegations of use and use in commerce since June 1994.

Examining Attorney's Position

The Examining Attorney has refused registration on the basis that applicants' asserted mark is *de jure* functional and that, if the asserted mark is determined not to be *de jure* functional, the mark is nevertheless not inherently distinctive. With respect to the *de jure* functionality refusal, the Examining Attorney argues that applicants' spherically curved brim is a superior design that other manufacturers need in order to effectively compete. The Examining Attorney points to several features of the brim that he asserts are primarily functional. The Examining Attorney maintains that the area of the brim that extends beyond the temple to cover the ears is functional because that part of the brim shades the ears. The Examining Attorney also notes that the curved inside of the brim is superior because it allows for the brim to be placed against the forehead.² The Examining Attorney also argues, brief, 4, that the spherical nature of applicants' brim allows for "a more even deflection of the sun's rays and precipitation and better allows precipitation to bead and roll off the brim."

² We note that the inside portion of the brim is shown in broken lines on the drawing, indicating that applicants do not claim exclusive rights to this part of the configuration.

In support of the functionality refusal, the Examining Attorney has submitted a number of utility patents covering headwear which, according to the Examining Attorney, include similarly designed brims that are crescent-shaped, curved and downward-shaped. The Examining Attorney, however, has not pointed to specific parts of these utility patents that demonstrate the *de jure* functionality of applicants' asserted mark. The Examining Attorney nevertheless notes that applicants' advertising literature touts the fact that the visor brim has "Unique Styling [which] Shades the Face AND EARS." (Emphasis in original.)³

With respect to the lack of inherent distinctiveness, the Examining Attorney argues that the catalog evidence made of record (some of which is shown below, from the Golf & Tennis Headwear Company catalog) demonstrates that applicants' design is a relatively common basic shape for brims, or is a mere refinement thereof. The Examining Attorney points to the fact that other brims closely resemble applicants', that they are curved in a similar manner and that they extend beyond the temple area to cover the ears. The Examining Attorney argues that, while

³ The literature also indicates that the molded brim "holds its shape permanently." It is not clear, however, whether conically shaped brims can also be said to hold their shape permanently. In any event, the Examining Attorney has not drawn our attention to this claim in the advertising literature.

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applicants' design might not be identical to others, it nevertheless is not an inherently distinctive configuration that serves to distinguish applicants' goods from those of others.

Applicants' Arguments

While applicants admit that the area of the brim beyond the temples which covers the ear is "not particularly unique," it is nevertheless applicants'

position that the dominant feature of their asserted mark is the overall sphericity of the visor, which feature, according to applicants, has no practical utility or functional advantage. Applicants' attorney contends that the spherical character of the asserted mark need not be copied by competitors because the same effect can be accomplished by a conventional brim. Applicants' attorney explains that a spherical visor must be molded rather than cut from flat material, as competitive visors are. Competitive visors are bent into a conical (rather than spherical) shape. See applicants' illustrations below.

According to applicants' attorney, there is a disadvantage to applicants' spherical visor because it does not flex and conform to the forehead as easily, it must be provided in different sizes, it is more complex in design and it requires a more sophisticated manufacturing process.

Moreover, applicants' attorney notes, applicants' visors require more material and are more expensive to make.

Conical visors, by contrast, are flexible and conform more readily to a wearer's forehead, according to applicants' attorney. Also, conical brims provide the same amount of protection from the sun and, according to applicants' attorney, applicants' brims do not perform better in the sense that they allow rain to roll off more easily.

Applicants' attorney contends that, due to the lower incline of the upper region of the brim, water does not run down their brim as readily it would on a conical brim.

In support of applicants' nonfunctionality argument, applicants submitted a declaration of Mr. Bennett, who stated his belief that "no other visor or cap manufacturer has gone to the trouble and expense of designing such an unusual and complex visor shape."

With respect to the issue of inherent distinctiveness, applicants argue that their design is unique and "highly distinctive" and that it so differs from conical visors that it is "unexpected" in the marketplace. Applicants contend that their visor is not a mere ornamental refinement but is a "strikingly original form of visor." Brief, 5.

Discussion and Opinion

The configuration or design of a product is *de jure* functional if it is so utilitarian as to constitute a superior design which others in the field need in order to compete effectively. In *re* Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA). Four factors enunciated by the Court in that opinion to be considered in determining the question of *de jure* functionality are:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design;
- (2) the touting by the originator of the design in advertising material of the utilitarian advantages of the design;
- (3) facts showing the unavailability to competitors of alternative designs; and
- (4) facts indicating that the design results from a relatively simple or cheap method of manufacturing the product.

See also *In re* Pingel Enterprise Inc., 46 USPQ2d 1811 (TTAB 1998); *In re* Caterpillar Inc., 43 USPQ2d 1335 (TTAB 1997) and *In re* American National Can Co., 41 USPQ2d 1841 (TTAB 1997).

In this case there appears to be no utility patent that discloses the specific utilitarian advantages of applicants' design. The third-party utility patents of record cover headwear in general and, as noted above, the

Examining Attorney has not pointed to any particular aspects of those patents which pertain to this configuration.

Except for the fact that applicants claim (and concede) that their brims shade the ears and the face, applicants do not tout the utilitarian advantages of the design. Also, the evidence of record shows that there are a number of alternative designs available to competitors. Finally, while we generally have nothing but argument from the attorneys on this point, applicants' attorney has made representations that its brim is more difficult and expensive to manufacture and requires more material. That is, applicants' visors appear not to be made by a relatively simple or cheap method of manufacturing.⁴ For all of these reasons, we conclude that the Examining Attorney has failed to prove that applicants' asserted design, incorporating a spherically curved brim, is essential for competitors and is therefore *de jure* functional.

With respect to the question of inherent distinctiveness, the Court in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA

⁴ Since this is not a matter that is obvious and because the burden of proof is on the Office, we do not believe that the

1977), looked to whether the trade dress at issue was a common basic shape or design, whether it was unique or unusual in a particular field or whether it was a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods, viewed by the public as a dress or ornamentation for the goods. See also *In re File*, 48 USPQ2d 1363 (TTAB 1998), and *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996), *aff'd*, unpublished, 1997 U.S. App. LEXIS 15556 (Fed. Cir. June 12, 1997). In support of his argument that applicants' design is but a mere refinement of other competitive brim designs, the Examining Attorney made of record copies of other caps and visors, reproduced above.

Suffice it to say that we agree with the Examining Attorney that applicants' asserted mark differs in only minor respects in appearance from other visor and brim designs. We cannot say that applicants' asserted mark is immediately recognizable as a distinctive way of identifying their goods. Although applicants' brims are spherical rather than conical, such difference, we believe, would not be readily apparent to ordinary purchasers, and even if they recognized this difference, we do not believe

Examining Attorney has carried his burden by argument alone on this point.

that purchasers would immediately see this feature as an indication of origin. We should point out that a particular configuration is not inherently distinctive merely because no other manufacturer uses the identical design. In re E S Robbins Corp., 30 USPQ2d 1540, 1542 (TTAB 1992). As stated in that case, at 1542:

Thus, while applicant's applied for design may be unique in the sense that it is a "one and only," the record demonstrates that said design is not unique in the sense it has an "original, distinctive, and peculiar appearance."

Decision: The refusal on the basis of *de jure* functionality is reversed, but the refusal on the ground that applicants' asserted mark is not inherently distinctive is affirmed.

R. L. Simms

G. D. Hohein

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
And Appeal